

Application No.: 09/913,833

Docket No.: 21499-00050-US

**REMARKS**

Claims 1-16, 23-30 and 32-36 are pending in this application. By this amendment, claim 31 has been canceled without prejudice or disclaimer of the subject matter contained therein. Applicant reserves the right to file a divisional application addressed to canceled claims 17-22 which were withdrawn from consideration by the Examiner.

***Allowable Subject Matter***

Claims 1-16 are allowed. Claims 24, 28-30 and 32-36 would be allowable if rewritten in independent form.

***Reasons for Entry of Amendments***

Claims 26 and 27 have been amended to correct formal errors cited by the Examiner. These amendment introduce no new issues for consideration by the Examiner.

***Claim Rejection Under 35 U.S.C. 102(b)***

Claim 23 stands rejected under 35 U.S.C. 102(b) as being anticipated by Cheetham (U.S. Patent No. 5,816,805). Applicant respectfully traverses.

The Examiner states that Cheetham shows a device 10 for filling teeth having a closed elongated container 28 and a tip 30. The Examiner further states that the tip 30 is inherently capable of being insertable into an interdental space because of the wide variety of interdental spaces that exist. The Examiner also states that Cheetham's structure is inherently capable of having a hole punched into it.

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Claim 23 recites:

...a closed first elongate and flexible container having means for inserting the first container into an interdental space between two adjacent teeth, said first container means being prefilled with a flowable restorative material which is disposed to flow into and fill a tunnel preparation when a hole has been punched into said first container means.

Cheetham fails to disclose a closed first elongate and flexible container having a "means for inserting the first container into an interdental space between two adjacent teeth" that is "prefilled with a flowable restorative material which is disposed to flow into and fill a tunnel preparation when a hole has been punched into said first container means" as is recited in claim 23. Instead, Cheetham discloses a capsule having a closed container conduit 28 that tapers to a plug 30. The plug 30 is not intended for insertion between teeth. Instead, amalgam is intended to be dispensed through the end of the conduit 28 after the plug 30 has been broken off.

Cheetham's plug 30 is intended for a use that is unrelated to the function recited in claim 23, and the plug 30 cannot be considered an equivalent to the claimed structure under 35 U.S.C. 112, sixth paragraph. The mere proposition that the plug 30 is capable of performing the function recited in the phrase "means for inserting the first container into an interdental space" does not render the structure disclosed in Cheetham an equivalent.<sup>1</sup> To the contrary, this analytical approach under 35 U.S.C. 112, sixth paragraph has been explicitly rejected by the Federal Circuit.<sup>2</sup>

In the present case, the lack of equivalence is highlighted by the fact that Cheetham's device is intended to apply condensable amalgam into a tooth cavity. Amalgam is not flowable and is applied by pressing the material into a cavity using a hand instrument. Further, amalgam cannot be inserted into a narrow tunnel preparation as a flowable composite. Therefore, it is not reasonable to consider the plug 30 of Cheetham as an equivalent to the structure shown in the present specification.

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In light of the above arguments, Applicant respectfully requests reconsideration and withdrawal of the rejection under 35 U.S.C. 102(b) based on Cheetham.

***Claims Rejection Under 35 U.S.C. 103(a)***

Claims 25 and 31 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Cheetham. Applicant respectfully traverses.

Cheetham fails to anticipate independent claim 23 as discussed above. The Examiner's statement of obviousness in the rejection of claims 25 and 31 fails to cure Cheetham's deficiencies in disclosing the device recited in claim 23. Therefore, Applicant respectfully request that the rejection under 35 U.S.C. 103(a) be withdrawn.

***Claim Rejection under 35 U.S.C. 112***

Claims 26, 27 and 31 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite.

Claims 26 and 27 have been amended to correct formal errors cited by the Examiner. Applicant therefore respectfully requests withdrawal of the rejection under 35 U.S.C. 112, second paragraph.

***Response to Arguments***

In the Examiner's response to arguments, he states that "it is only necessary for the prior art to be capable of functioning as claimed." This is an improper statement of the law under 35 U.S.C. 112, sixth paragraph.<sup>3</sup> Instead, means plus function limitations can only be anticipated by a prior art element that is an equivalent to the structure disclosed in the specification that corresponds to the means plus function limitation.<sup>4</sup> As discussed above, the

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<sup>1</sup> See MPEP 2181.

<sup>2</sup> *Id.* (citing *In re Donaldson, Co.*, 16 F.3d 1189, 1850 (Fed. Cir. 1994)).

<sup>3</sup> *Id.*

<sup>4</sup> *Id.*

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structure of Cheetham cannot be considered an equivalent to the structures disclosed in the present specification under any reasonable interpretation. Cheetham's device is clearly addressed to a method of application that is unrelated to the methods disclosed in the present specification. Applicant therefore respectfully requests reconsideration and withdrawal of the rejections based upon Cheetham.

### *Conclusion*

In light of the above arguments, Applicant respectfully requests reconsideration and withdrawal of all outstanding rejections and immediate allowance of the application.

In view of the above amendment, applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 22-0185, under Order No. 21499-00050-US from which the undersigned is authorized to draw.

Dated: July 23, 2004

Respectfully submitted,

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